

The Office Action rejects claims 1-3, 5-7 and 9-11 under 35 USC §103(a) over U.S. Patent 5,815,704 to Shimotsuji et al. (hereinafter, "Shimotsuji"). This rejection is respectfully traversed.

Contrary to an assertion in the Office Action, Shimotsuji does not disclose "extracting conditions input means for inputting a condition of extracting a specific data input form out of the plural data input forms" as recited in claim 1.

In column 1, lines 37-39, Shimotsuji merely discloses "a plurality of form data registered in the file memory are displayed in order and the user selects one form in which he wants to observe the document." This relates to displaying form data, not to a condition of extracting a specific data input form out of plural data input forms.

In column 2, line 15, Shimotsuji discloses "image input means for inputting image data of a new document." This simply discloses that Shimotsuji has a means to input image data for a new document. This only concerns having an image input means and has nothing to do inputting extracting conditions.

Thus, Shimotsuji does not disclose "extracting conditions input means for inputting a condition of extracting a specific data input form out of the plural data input forms," as recited in claim 1.

The Office Action admits that Shimotsuji does not disclose "the claimed character string extracting means in detail as for extracting a character string out of each of a plural data input forms containing character strings." Unfortunately, this admittedly missing feature is not found in the claims. What is recited in the claims is "data input extracting means for extracting the specific data input form by retrieving the character string extracted by the character string extracting means in accordance with the extracting conditions inputted by the extracting condition input means."

The Office Action concludes that it would be obvious to "modify the teaching of Shimotsuji wherein the character-line extraction means for extracting line data and character data from the input image data extracts character string out of each of plural data input forms containing character strings." Unfortunately, that which the Office Action alleges is obvious is not the claimed invention.

Moreover, because Shimotsuji does not disclose the extracting conditions input means, for the reasons stated above, Shimotsuji does not disclose "data input extracting means for extracting the specific data input form by retrieving the character string extracted by the character string extracting means in accordance with the extracting conditions inputted by the extracting condition input means," as recited in claim 1.

The alleged motivation to modify Shimotsuji in the manner suggested, i.e. for "effectively registering" and "easily retrieving" a document from memory, is already achieved by Shimotsuji. Thus a person skilled in the art would not have been motivated to there would be no incentive to further modify Shimotsuji to achieve such purposes. Additionally, evidence of motivation must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617. There is no such evidence of record, the only reference being applied being Shimotsuji. In this regard, it is also noted that a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusionary statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). As Shimotsuji, the only evidence of record in this rejection, does not even suggest doing what is allegedly obvious to do, the motivation for modifying Shimotsuji must be based on improper speculation and/or impermissible hindsight.

The assertions in the Office Action regarding the rejection of independent claims 5 and 9 are similarly inapposite and unsupported.

In summary, Shimotsuji does not disclose the second and third positively recited clauses in the body of claims 1, 5 and 9; the Office Action does not provide proper evidence of motivation to modify Shimotsuji to achieve the claimed invention; the Office Action fails to address the claimed invention in regard to the alleged modification of Shimotsuji; and, the proposed modification of Shimotsuji, even if proper, would not render the claimed invention obvious.

Accordingly, the rejection of claims 1-3, 5-7 and 9-11 under 35 USC §103(a) over U.S. Patent 5,815,704 to Shimotsuji is improper and should be withdrawn.

The Office Action rejects claims 4, 8 and 12 under 35 USC 103(a) as unpatentable over Shimotsuji in view of U.S. patent 5,438,657 to Nakatani. This rejection is respectfully traversed.

Shimotsuji does not disclose extracting condition input means for inputting a condition of extracting a specific data input from out of the plural data input forms for the reasons stated above.

Shimotsuji admittedly does not disclose "data input form extracting means for extracting the specific data input form by retrieving the keyword added by the keyword adding means in accordance with the extracting conditions inputted by the extracting condition input means," as recited in claim 4.

The Office Action alleges that Nakatani teaches data input form extracting means for extracting the specific data input form by retrieving the keyword added by the keyword adding means in accordance with the extracting condition input means, referencing column 11, lines 18-23 of Nakatani.

This referenced text of Nakatani merely discloses extracting a block in table 1 which is detected by referring to the keyword dictionary that a keyword associated with "date" is included in the character string of the block. Nakatani does not disclose keyword adding means, as recited. Nor does Nakatani disclose the extracting condition means or that a keyword was added in accordance with extracting condition input means.

The Office Action then asserts that it would be obvious to combine the teaching of Shimotsuji with the teaching of Nakatani "wherein input form is extracted based on the associated keyword entered." The alleged motivation for this is "that searching for specific character string based on keyword input is made easy and less time consuming since keywords are associated with specific input forms."

The alleged motivation to modify Shimotsuji in the manner suggested, i.e. "wherein input form is extracted based on the associated keyword entered" is not explained in sufficient detail to understand what aspect of Shimotsuji is being modified and why adding an additional feature of adding a keyword to Shimotsuji (in an unspecified manner) would result in Shimotsuji's system being made "easy and less time consuming." Accordingly, the Office Action fails to make out a prima facie case of obviousness of the claimed invention including failing to provide a proper incentive to one of ordinary skill in the art to further modify Shimotsuji.

Additionally, Nakatani does not suggest providing keyword adding means as part of its system. It simply identifies keywords already entered in a document. As noted above, evidence of motivation must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617. There is no such evidence of record, neither Shimotsuji nor Nakatani providing such evidence. In this regard, it is also noted that a factual inquiry whether to modify a reference must be based on objective evidence of

record, not merely conclusionary statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). As neither Shimotsuji nor Nakatani do not even suggest doing what is allegedly obvious to do, the motivation for modifying Shimotsuji must be based on improper speculation and/or impermissible hindsight.

Finally, even if the references were properly combined, which they are not, they would not result in the claimed invention, none of the features recited in the claims are found in these references.

The assertions in the Office Action regarding the rejection of claims 8 and 12 are similarly inapposite and unsupported.

In summary, neither Shimotsuji nor Nakatani discloses the first, second and third positively recited clauses in the body of claims 4, 8 and 12; the Office Action does not provide proper evidence of motivation to modify Shimotsuji to achieve the claimed invention; and the proposed modification of Shimotsuji in view of Nakatani, even if proper, would not render the claimed invention obvious.

Accordingly, the rejection of claims 4, 8 and 12 under 35 USC §103(a) over Shimotsuji in view of Nakatani is improper and should be withdrawn.

In view of the foregoing, it is respectfully submitted that claims 1-12 are in condition for allowance.